

REMARKS

This paper responds to the Advisory Action mailed on August 13, 2009 and the Examiner Interview conducted August 31, 2009. Claims 1, 4, 8, 10, 12, 15, 19, 21, 23, 26, 30, 32, 34, 37 and 43 have been amended herein, claims 2, 13, 24, and 35 have been cancelled herein, and no claims have been added; as a result, claims 1, 4-8, 10-12, 15-19, 21-23, 26-30, 32-34, 37-41, and 43-48 are now pending in this application.

Interview Summary

Applicant additionally thanks Examiner David England for the courtesy of a telephone interview on August 31, 2009 with the Applicant's representatives, Karen Kaufman and Roy Lin.

In the telephone interview, the Examiner and representatives discussed the rejection Applicant's independent claims in view of the cited art (Flanagan, Gastaldo, Appleby, and Scanlan), as well as several proposed amendments. However, no consensus could be reached.

§ 103 Rejection of the Claims

Claims 1, 4-5, 10-12, 15-16, 21-23, 26-27, 32-34, 37-38 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flanagan et al. (U.S. Patent No. 5,966,685, hereinafter, "Flanagan") in view of Appleby (U.S. Patent No. 6,463,404) in further view of Gastaldo et al. (U.S. Patent No. 6,473,729, hereinafter; "Gastaldo").

Claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flanagan, Appleby and Gastaldo in further view of Scanlan (U.S. Patent No. 6,857,022).

In the recent decision of the Supreme Court on *KSR Int'l Co. v. Teleflex Inc.*¹, the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*² was reaffirmed. The Court in *Graham* set out an objective analysis for applying §103 as follows:

¹ 127 S.Ct. 1727, 82 USPQ.2d 1385 (2007).

² 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.”³

When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.”⁴ In so doing, the Examiner must make use of the factual determinations set forth in *Graham v. John Deere Co. of Kansas City*.⁵

References do not teach “receiving, from said first entity, a first numerical identifier of a first language construct selected by the first entity from said plurality of predetermined language constructs in the first language, the first numerical identifier comprising a numerical indicator of the first language construct and not including the text of the first language construct”

To more clearly point out the differences between the claimed invention and the prior art, Applicant has amended claim 1 to recite, in pertinent part, “receiving, from said first entity, a first numerical identifier of a first language construct selected by the first entity from said plurality of predetermined language constructs in the first language, the first numerical identifier comprising a numerical indicator of the first language construct and not including the text of the first language construct.”

In the most recent Office Action, the Examiner acknowledged that “Flanagan does not specifically teach receiving, from said first entity, an identifier of a first language construct from said plurality of predetermined language constructs.”⁶ Applicant submits that, as a result, Flanagan also cannot teach “receiving, from said first entity, a first numerical identifier of a first language construct selected by the first entity from said plurality of predetermined language constructs in the first language, the first numerical identifier comprising a numerical indicator of

³ The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

⁴ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

⁵ 383 U.S. 1 at 467.

⁶ The Office Action at para. 9.

the first language construct and not including the text of the first language construct” as recited in claim 1.

Applicants further submit that Gastaldo does not teach “receiving, from said first entity, a first numerical identifier of a first language construct selected by the first entity from said plurality of predetermined language constructs in the first language, the first numerical identifier comprising a numerical indicator of the first language construct and not including the text of the first language construct.”

Gastaldo discusses a system for “assisting a translator to get the right translation for any phrase.”⁷ In Gastaldo,

the user inputs the text to be translated in step 31. The text is then displayed so that the user can select an unknown word or group of words, e.g. by double-clicking the word. Once a word has been selected in step 32, phrase extractor 15 extracts in step 33 all the possible noun phrases relating to the selected word. The set of possible noun phrases is then displayed [to the user] in step 34, and one of the displayed noun phrases is selected [by the user], in step 35.⁸

Once the user has selected one of the possible noun phrases, control unit 14 queries the phrase-indexed sentence database 17 in step 41. ... Thus, the system is able to present to the user in step 43 all the pairs of sentences with those sentences first which are closest to the one to be translated. An example of a displayed sorted set of paired sentences is depicted in FIG. 5 as field 54.⁹

In step 44 of FIG. 4 the user selects one of the displayed sentences of field 54 which is then copied to fields 56 and 57 to allow the user to more intensively study the proposed translation. Once the user has decided that the selected pair of translated sentences should be used for translating the selected word of the input test, phrase extractor 15 extracts in step 45 from the selected sentence pair the noun phrase translation and inserts the translated noun phrase automatically into the translation of the input text.¹⁰

(emphasis added)

⁷ Gastaldo, col. 1, lines 7 and 53-55.

⁸ Gastaldo, col. 5, lines 35-43.

⁹ Gastaldo, col. 5, line 60 – col. 6, line 7.

¹⁰ Gastaldo, col. 6, lines 9-17.

In Gastaldo, a user “inputs the text to be translated” and “can select an unknown word or group of words, e.g. by double-clicking the word” that is to be translated by the system.¹¹ Clearly, the inputting of text or selection of a word or group of words is not the same as “receiving, from said first entity, a first numerical identifier of a first language construct selected by the first entity from said plurality of predetermined language constructs in the first language, the first numerical identifier comprising a numerical indicator of the first language construct and not including the text of the first language construct.”

Also discussed above, in Appleby, a translator program receives text from a client terminal, interacts with the user as necessary in order to clarify the text, and produces a translation of the text for supply back to the user.¹² There is no indication or hint of a “receiving, from said first entity, a first numerical identifier of a first language construct” where “the first numerical identifier comprising a numerical indicator of the first language construct and not including the text of the first language construct.” Therefore, neither Flanagan, Appleby, nor Gastaldo teach the limitation in claim 1 of “receiving, from said first entity, a numerical identifier of a first language construct from said first plurality of predetermined language constructs, the numerical identifier comprising a numerical indicator of the first language construct and not including the text of the first language construct itself.” Similarly, the references also fail to teach the “a translated language construct corresponding to said first numerical identifier” and “each predetermined language construct of the plurality of language constructs in the second language being associated with the predetermined numerical identifier.”

As Flanagan, Appleby, and Gastaldo fail to teach every feature of the claimed invention and the references do not teach what they are relied upon to teach, it would not have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Flanagan using the teachings of Appleby and Gastaldo to achieve the claimed invention. Applicants respectfully submit that independent claim 1 and its dependent claims are not obvious over Flanagan, Appleby, and Gastaldo.

¹¹ Gastaldo, col. 5, lines 35-43.

¹² Appleby col. 3, lines 54-60.

References do not teach “communicating a plurality of predetermined language constructs in a second language to the second entity in a second set of one or more interactive fields, second entity to respond to the first entity by selecting a second language construct from the plurality of predetermined language constructs in the second language.”

In the Office Action, the Examiner acknowledged that “as closely interpreted by the Examiner, Flanagan, Appleby and Gastaldo do not specifically teach communicating a plurality of interactive fields to said second entity in said second transmission to allow said second entity to interact with at least one interactive field of said plurality of interactive fields in response to said translated language construct.”¹³ Instead, the Examiner argues that “from language” and “to language” pull-down lists discussed in Scanlan teaches these limitations.¹⁴

Claim 1 has also been amended to recite the similar limitations of “communicating a the plurality of predetermined language constructs in a second language to the second entity in a second set of one or more interactive fields, the second entity to respond to the first entity by selecting a second language construct from the plurality of predetermined language constructs in the second language.” As a result, Applicant submits that Flanagan, Appleby and Gastaldo do not teach these limitations. Applicant further submits that Scanlan does not teach these limitations for the reasons set forth below.

Scanlan discusses a one-click translation ordering system in which a customer can request a translation of a web page with a single action.¹⁵ “Once the translation is requested by a single action, the web page, a selected part of the web page, the URL of the web page or other indicator is transferred 5 to a translation manager. ... The translation manager 4 processes the request by translating the text ... and optionally adding further information. The translated web page 7 is transferred to the customer’s browser and displayed in the requested language.”¹⁶ Where the single action to request a translation is embodied in an explorer bar that implements a one-click translation component,¹⁷ the explorer bar may contain “from language” and “to

¹³ The Office Action at para. 27.

¹⁴ The Office Action at para. 27; See also Scanlan at col. 3, line 63 – col. 4, line 13.

¹⁵ Scanlan at col. 3, lines 3-9.

¹⁶ Scanlan at col. 3, lines 14-17 and 32-37.

¹⁷ See Scanlan at col. 3, lines 48-51.

language” pull-down lists that allow the user to select different translation options.¹⁸ Figure 2 of Scanlan illustrating the explorer bar with the pull-down lists is provided below.

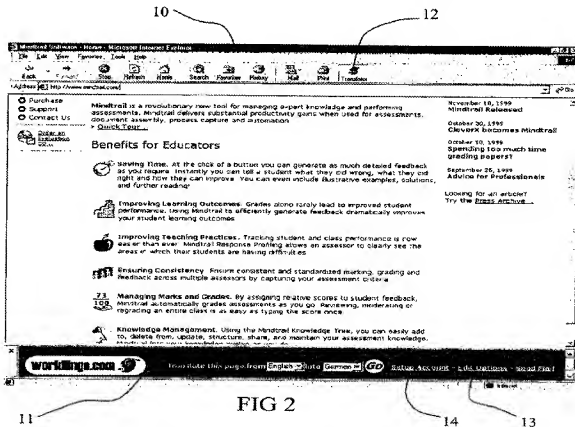


FIG 2

In Scanlan, the pull-down lists allow a user “to select different translation options”¹⁹ before translation of the web page such as a “from language” and a “to language.”²⁰ Thus, in Scanlan, the pull-down lists are for selecting translation options and not for responding to a translated language construct. In fact, in Scanlan, the user selects the translation options using the pull-down lists before any translation is performed. In contrast, amended claim 1 recites “communicating a second plurality of predetermined language constructs to the second entity in one or more interactive fields, the second user to respond to the translated language construct by making a selection of a language construct from the second plurality of predetermined language constructs.”

¹⁸ Scanlan at col. 3, lines 63-65.

¹⁹ Scanlan at col. 3, lines 64-65.

²⁰ See Scanlan at col. 3, lines 51-57 and col. 3 line 63 – col. 4 line 13.

As Flanagan, Appleby, Gastaldo, and Scanlan fail to teach every limitation of the claimed invention, it would not have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Flanagan using the teachings of Appleby, Gastaldo, and Scanlan to achieve the claimed invention. Applicants respectfully submit that claim 1 and its dependent claims are not obvious over Flanagan, Appleby, Gastaldo, and Scanlan.

Further, with respect to dependent claims 47 and 48, which depend indirectly on claim 1, the Examiner asserts that the plurality of interactive fields and that Scanlan teaches “of said second entity that will receive the email with the translated language.” However, claim 47 is not directed to receiving email in the translated language. Rather, claim 47 recites:

wherein said plurality of interactive fields includes a first interactive field, wherein said first interactive field includes a drop down list that contains a second plurality of predetermined language constructs that respectively respond to said predetermined question and are respectively translated into a second language based on a language preference of said second entity.

Instead of providing language constructs that respond to a question, Scanlan teaches an email service. Rather and as discussed above, a user of the combination proposed by the Examiner would either enter text to be translated as discussed in Flanagan and Scanlan, or select a noun phrase from an existing document as discussed in Gastaldo. As such, Scanlan, either singly or in combination with the other cited references that merely teach translating received text, teaches “a second plurality of predetermined language constructs that respectively respond to said predetermined question.”

Obviousness in light of the prior art

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.”²¹ Furthermore, “[d]istilling an

²¹ MPEP 2141.02 (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)).

invention down to the 'gist' or 'thrust' of an invention disregards the requirement of analyzing the subject matter 'as a whole.'"²²

Taking the presently claimed invention as a whole, Applicants submit that the references cited by the examiner do not teach at least the 3 limitations of the claimed invention presented above. As Flanagan, Appleby, Gastaldo, and Scanlan fail to teach multiple limitations of the claimed invention, it would not have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Flanagan using the teachings of Appleby, Gastaldo, and Scanlan to achieve the claimed invention. Applicants respectfully submit that claim 1 and its dependent claims are not obvious over Flanagan, Appleby, Gastaldo, and Scanlan.

Independent claims 12, 23, and 34 have been amended to recite similar limitations. As a result, Applicants further submit that claims 12, 23, 34, and their respective dependent claims are not obvious over Flanagan, Appleby, Gastaldo, and Scanlan. The respective dependent claims may be patentable for their own limitations.

²² MPEP 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

CONCLUSION

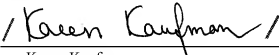
Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4051 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 04 September 2009

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4th day of September, 2009.

Chris Bartl
Name


Signature